Remarks

Claims 1-6, 8-14, 19 and 20 are currently pending. Claim 1 has been amended. Claims 7 and 15-18 have been canceled. Support for the amendment to claim 1 can be found in the specification and claims as originally filed.

The claim amendments and cancellations should not be construed to be an acquiescence to any of the claim rejections. Rather, the amendments and cancelations are being made solely to expedite prosecution. The Applicants expressly reserve the right to prosecute further the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120 and § 121.

Claim Rejections - 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Weiss et al., ("Weiss", US 6,756,024) in view of Morrison et al. ("Morrison", US 4,206,191). The Applicant respectfully traverses.

To establish a *prima facie* case of obviousness, a number of criteria must be met. For example, all of the limitations of a rejected claim must be taught or suggested in the prior art reference (or references when combined) relied upon by the Examiner; or they must be among the variations that would have been "obvious to try" to one of ordinary skill in the relevant art in light of the cited reference(s). Moreover, one of ordinary skill in the relevant art must have a reasonable expectation of success in light of the cited reference or combination of references. Importantly, the reasonable expectation of success must be found in the prior art, and may not be based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991); *see* MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

Claims 7 and 15-18 have been canceled, thus rendering the rejection of these claims moot. As to the remaining claims, the Applicants assert that the Examiner has failed to state a *prima facie* case of obviousness, as the cited references do not teach or render "obvious to try" each and every element of Applicants' amended claims. Applicants' claim 1 covers a process for preparing a lithium amide composition comprising the steps of: (1) contacting lithium metal

with ammonia to form lithium bronze; and (2) reacting the lithium bronze with a 1,3-diene or an arylolefin in the presence of a solvent, thereby providing a lithium amide composition. Applicants' claimed process includes the limitation that the temperature of the process be maintained between -33 and -78 °C. The combination of references does not teach or render "obvious to try" this temperature limitation.

Weiss discloses a method for preparing lithium amide at ambient temperature; i.e., the temperature of the reaction lies between 0 and 30 °C. A critical feature of the Weiss method is that the reaction is performed at ambient temperature to prevent hydrogen formation and thermal loading of the product. Morrison discloses a method for preparing lithium amide by mixing bulk pieces of lithium metal with a catalyst such as active metal cobalt in an inert liquid aromatic hydrocarbon, such as toluene, at a temperature from 0 to -60°C. Anhydrous ammonia is then added and two immiscible phases are formed.

The combination of Weiss and Morrison does not teach or render "obvious to try" all of the limitations of the amended claims because Weiss teaches that the use of ambient temperature prevents hydrogen formation and thermal loading of the product. Consequently, Weiss can be said to "teach away" from the claimed temperature range. Importantly, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

Additionally, in light of the cited references, one of ordinary skill in the art would not have had a reasonable expectation of success in arriving at Applicants' claimed process because, as discussed above, the references teach away from the use of temperatures in the claimed range between -33 and -78 °C. Moreover, the method taught by Morrison requires a catalyst, such as active metallic cobalt; whereas, the Weiss method does not employ a catalyst. Accordingly, one of ordinary skill could not have reasonably expected success in a method at a temperature outside the range required by Weiss and without the benefit of a catalysts akin to that required in

the methods of Morrison. Applicants respectfully remind the Examiner that one must consider the invention as a whole and without the benefit of hindsight when making an obviousness determination based on 35 U.S.C. § 103. *See* MPEP 2141.

Accordingly, the Applicants respectfully request the withdrawal of the claim rejection based on 35 U.S.C. § 103(a).

Fees

The Applicants believe they have provided for all required fees in connection with the filing of this paper. Nevertheless, the Commissioner is hereby authorized to charge any additional required fees due in connection with the filing of this paper to our Deposit Account, **06-1448** reference **HGX-003.01**.

Conclusion

In view of the above amendments and remarks, it is believed that the pending claims are in condition for allowance. If a telephone conversation with the Applicants' Agent would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned at (617) 832-1000.

Respectfully submitted,
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